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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/680,901	10/06/2003	David Joe Steele	2003-IP-012001	6365
30652	7590	08/25/2005	EXAMINER	
CONLEY ROSE, P.C. 5700 GRANITE PARKWAY, SUITE 330 PLANO, TX 75024			DANG, HOANG C	
			ART UNIT	PAPER NUMBER
			3672	
DATE MAILED: 08/25/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/680,901

Applicant(s)

STEELE ET AL.

Examiner

Hoang Dang

Art Unit

3672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-52 and 63-73 is/are pending in the application.
- 4a) Of the above claim(s) 53-62 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 19, 21, 23-29, 31-52 and 63-73 is/are rejected.
- 7) ☒ Claim(s) 9-18, 20, 22 and 30 is/are objected to.
- 8) ☒ Claim(s) 53-62 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/29/04 &amp; 3/31/04</u> | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election of Group I, claims 1-54 and 63-73 in the reply filed on June 14, 2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 55-62 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on June 14, 2005.

### *Claim Objections*

3. Claims 23-30, 43, 45, 46 and 54 are objected to because of the following informalities: The following expressions have no proper antecedent basis: "the condensate" (claim 23, line 1; and claim 24, line 1; claim 25, line 1; claim 26, line 1; and claim 27, line 1; claim 28, line 1; claim 29, line 1 and claim 30, line 1); "the steam boiler" (claim 43, line 1); "the means for recovering oil" (claim 45, line 1; claim 46, line 1); "the condensate recovery conduit" (claim 46, lines 1-2); "the oil recovery conduit" (claim 54, lines 1-2) . Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

4. Claims 19 and 53 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-4, 21, 23, 25-27, 31, 33, 34, 38, 41, 49 and 53 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Hsueh (US 4,696,345) (see figure 1 and column 2, line 53 through column 3, line 26).

As for claim 26, oil and condensate are recovered from the production well.

As for claim 27, oil is recovered from the production well and condensate is recovered from the HAS pipe.

As for claim 38, the recited “steam trap” does not distinguish from the horizontal annulus portion of the HAS pipe.

7. Claims 1-6, 21, 23-31, 33, 41, 42, 44-52, 63-66, 69-71 and 73 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Vandergrift (US 4,099,570) (see the entire patent in particular figures 1-5; column 2, lines 20-48; column 4, lines 22-52; column 5, lines 22-28; column 6, lines 3-14; column 6, lines 33-44 and column 6, lines 55-62).

As for claim 6, see column 3, lines 21-27.

As for claims 27-28 and 41, see column 6, lines 3-14.

*Claim Rejections - 35 USC § 103*

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vandergrift '570 in view of Sanchez (5,148,869).

Vandergrift discloses the invention as claimed except for injection of an oil-soluble fluid into the subterranean formation before, after or concurrent with the injection of steam. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add an oil soluble fluid into the formation with steam as claimed in view of the teaching of Sanchez in order to enhance the recovery of oil (see column 3, lines 1-39).

10. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Vandergrift '570 in view of Rogers et al (US 4,765,410) or Rivas et al (US 4,678,039).

Vandergrift discloses the invention as claimed except for the use of a chemical to reduce contaminants in the loop system. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a chemical with the steam injection of Vandergrift in order to disintegrate contaminants in the wellbore and in the formation matrix as taught by Rogers et al (see the abstract) or Rivas et al (see column 3, lines 28-31).

11. Claims 34-40 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vandergrift '570 in view of Gregoli et al (US 6,016,868) or Young et al (US 3,809,159).

Art Unit: 3672

Vandergrift discloses the invention as claimed except for the use of a steam boiler that is fired from hydrocarbons recovered from the wellbore. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to generate steam in Vandergrift using a boiler which is fired by hydrocarbons produced from the well because either Gregoli et al or Young et al teach using a steam boiler to produce steam that is injected into a formation and using gas produced from the formation to operate the steam boiler (see column 31, lines 28-32 in Gregoli et al and column 3, lines 33-40).

As for claims 36-37, see column 5, lines 22-28 in Vandergrift.

As for claims 38, the "steam trap" does not distinguish from the annulus formed between the outer casing and inner steam injection pipe in Figures 2-5 of Vandergrift.

As for claims 39 and 40 the use of a pump to boost the pressure of the pumped fluids and the use of a flash tank to adjust the pressure of the produced fluids are well known in the art and would have been obvious.

12. Claims 67, 68 and 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vandergrift '570 in view of Sheinbaum (US 4,364,232).

Vandergrift discloses the invention as claimed except that the valves of Vandergrift are not disclosed as actuatable by heat. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a thermally operated valve in Vandergrift because thermally operated valves are well known and used in a well to control the flow of hot or heated fluids as evidenced by Sheinbaum (see column 13, lines 62-63).

***Allowable Subject Matter***

13. Claims 9-18, 20, 22 and 30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Specification***

14. The disclosure is objected to because of the following informalities: The copending application recited on page 1 should be updated.

Appropriate correction is required.

***Conclusion***

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

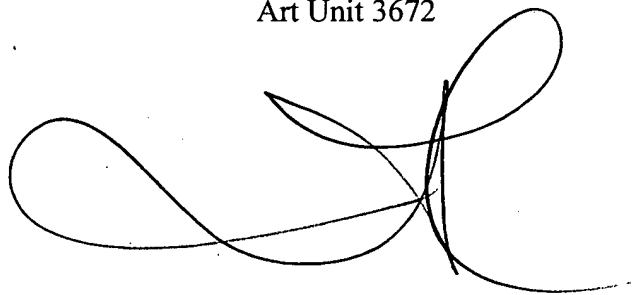
16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoang Dang whose telephone number is 571-272-7028. The examiner can normally be reached on 9:15-5:45 Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoang Dang  
Primary Examiner  
Art Unit 3672

A handwritten signature in black ink, consisting of a large, stylized 'H' followed by a vertical line and a loop.